

Appl. No. 10/066,595
Amdt. Dated Oct 04, 2004
Reply to Final Action of Sep 10, 2004

MAIL STOP AF

Remarks

The indication of allowable subject matter in claim 13 is noted with appreciation.

However, the applicants respectfully submit that the Examiner's interpretation of the language of claim 12 is unduly far-fetched and unnatural. The claims are directed to persons of ordinary skill in the art using such language as would be understood by such persons. The wording "cyclically operating" in the context of claim 12 does not describe an act; rather when properly interpreted in the context of an apparatus claim it clearly describes a type of pump, namely one that is configured or designed to operate cyclically. One can buy cyclically operating, or "cyclic pumps". It would be evident to one skilled in the art within the context of an apparatus claim that a cyclically operating pump is a type of pump that operates cyclically when you switch it on.

For example, while the expression "a fishing boat" could in theory mean a boat that is in the act of fishing, context and common sense normally dictate otherwise. The phrase has to be viewed in context, but clearly it would normally describe a type of boat that was configured for fishing. A flying boat normally means a boat designed to fly, not one that is in the act of flying. Obviously the precise meaning of any phrase depends on the context, but clearly in the context of an apparatus claim "a cyclically operating pump" must be a pump configured to operate cyclically. The Examiner's objection might have had a valid basis if claim 12 just recited "a pump, ... wherein said pump is operated cyclically" but that is not what the claim says. The claim recites a type of pump, namely a cyclically operating pump, or in other words a cyclic pump.

While the applicants do not concede there was any ambiguity in the original language when properly taken in context, the language "cyclic pump" has been employed in amended claim 12 to avoid possible ambiguity over what was meant by the expression cyclically operating pump in the previous claim (i.e. it was not intended to imply that the pump was in operation in view of the fact that the claim is an apparatus claim). The

Appl. No. 10/066,595
Amdt. Dated Oct 04, 2004
Reply to Final Action of Sep 10, 2004

MAIL STOP AF

claim language now specifies that the "cyclic pump" is configured to ensure that intermittent supply, which was clearly what was intended by the original expression.

Moreover, this interpretation of claim 12 ties in with the functional language in the whereby clause that the discrete quantities of syrup are axially located in the flowing liquid. This effect occurs when the apparatus is in use because of the presence of the structure set forth including the cyclically operating pump (or cyclic).

Functional limitations have been approved on many occasions by the courts. For example, in *In Re Mills* 16 USPQ 2d 1430, the Federal Circuit specifically approved and gave patentable weight to a claim that recited:

"drive motor means connected through gearbox means providing a pumping capacity of the pump means greater than the feed rate of the ingredients to the mixing chamber provided by the feed means, such that in operation air is drawn into the mixing chamber, and entrained in mixed ingredients."

The court specifically acknowledged that the difference between the prior art and the claim lay in the functional limitations of the pump means and the feed means providing a pumping capacity.

Since the claim is an apparatus claim the whereby clause does not recite an act but rather must characterize the apparatus itself. The wording "whereby said lipid-based formulation is evenly colored by said color syrup additive as it exits said mixing body at said outlet tube" must mean that the mixing body is configured to ensure this result, or in other words includes means for ensuring this result. The applicants have now positively recited that the mixing body includes means for ensuring this result, but in the applicant's respectful submission when properly interpreted the amended language has essentially the same meaning as the previous language.

It is respectfully submitted that the Examiner should give patentable weight to these features for the reason's noted above. When such features are given their proper consideration, it is respectfully submitted that Gray is not relevant because it clearly does not teach an apparatus that is capable of providing discrete quantities of spaced-

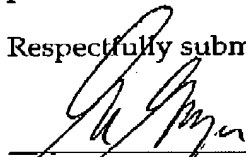
Appl. No. 10/066,595
Amdt. Dated Oct 04, 2004
Reply to Final Action of Sep 10, 2004

MAIL STOP AF

apart colored syrup in a lipid-based formulation. Gray must be treated as non-analogous art since it does not relate to the addition of colored syrup to a lipid-based solution and moreover relates to an entirely different problem. A person skilled in the art would have no motivation to modify Gray to provide a cyclically operating pump since such modification would be inconsistent with the objects of Gray.

The basic problem seems to be the manner in which the Examiner has interpreted the claim language. It is believed that the amended claim language overcomes this problem and that the application is now in condition for allowance, and such action is respectfully requested. However, if the Examiner has any outstanding issues, he is respectfully requested to telephone the undersigned because it appears that the problem is fundamentally one of appropriate language rather than substance.

Respectfully submitted,



George M. MacGregor
Registration No. 37,547
Agent of Record

MARKS & CLERK
P. O. Box 957, Station B,
Ottawa, Ontario, Canada
K1P 5S7
(613) 236-9561

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.